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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,551	12/03/2003	Chang-Chi Lee	MR1715-81	3997

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ELLICOTT CITY, MD 21043

EXAMINER

MAYO III, WILLIAM H

ART UNIT PAPER NUMBER

2831

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/725,551

Applicant(s)

LEE, CHANG-CHI

Examiner

William H. Mayo III

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on August 24, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on August 24, 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on August 24, 2004. These drawings are not approved because the cross hatching to indicate the insulation material and jacket materials is improper. The applicant should refer to MPEP Section 608.02 for the proper cross-hatching of materials. Correction is required.
2. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Marked-up Drawings" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

### ***Claim Objections***

3. Claim 1 is objected to because of the following informalities: The applicant should replace the term "comprise" in line 2 to --comprising--, "comprise" in line 3 to --comprising--, "comprise" in line 4 to --comprising--, "the large solid conductor" to --a large solid conductor--, and "the fourth core" to --a fourth core--. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. Claim 2 recites the limitation "the said solid conductor" in lines 2-3, which is confusing and renders the claim indefinite. It is unclear whether the applicant is referring to the previous mentioned "small solid conductor" or "large solid conductor". The applicant should recite the term with consistency to specify which solid conductor is being addressed.

7. Claim 3 recites the limitation "the said solid conductor" in lines 2-3, which is confusing and renders the claim indefinite. It is unclear whether the applicant is referring to the previous mentioned "small solid conductor" or "large solid conductor". The applicant should recite the term with consistency to specify which solid conductor is being addressed.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 2831

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eichmann et al (Pat Num 6,495,763, herein referred to as Eichmann) in view of Applicant's Own Admission of Prior Art (herein referred to as AOAPA). Eichmann discloses an audio and video signal cable (Figs 1-9, Col 1, lines 1-16). Specifically, with respect to claim 1, Eichmann discloses a cable (Fig 4) comprising a solid conductor (second 13), that may be rectangular in shape (Col 3, lines 1-5) and is surrounded by an insulation (second 3) forming at least a first core (Fig 4), a small solid conductor (13) surrounded by an insulation layer (3) forming at least a second core (Fig 4), a large solid conductor (14) surrounded by an insulation layer (3) forming at least a third core (Fig 4), and a solid conductor (third 13), that may be rectangular in shape (Col 3, lines 1-5) and is surrounded by an insulation (second 3) forming at least a fourth core (Fig 4), wherein the each of the cores (Fig 4) are assembled and may be twisted into a twisted cord (Col 3, lines 10-12), wherein all of the cores (Fig 4) have a gauge and a cross sectional area associated respectively, wherein each gauge and the cross sectional areas are selected depending on the particular application of the cable (Col 2, lines 1-60), and wherein each of the cores (Fig 4) are covered by a shielding (15) and a jacket (outer 4) thereby forming the cable (Fig 4), wherein the small solid conductor (13), the large conductor (14) and the solid conductor (third conductor, 13), that may be rectangular in shape (Col 3, lines 1-5) are litz style cores (Col 4, lines 25-30). With respect to claim 2, Eichmann discloses that the solid conductor (second 13) is cross sectionally circular in shape (Col 3, lines 1-5). With respect to claim 3, Eichmann

Art Unit: 2831

discloses that the solid conductor (second 13) may have a flat shape (rectangular, Col 3, lines 1-5).

However, Eichmann doesn't disclose the cable having an insulated tinsel conductor, nor the solid conductor being selected from the group consisting of silver copper alloy, two or more tinsels, two lengths of enamel covered wire or two lengths of 100% fiber covered copper (claim 1).

AOAPA teaches under the heading "Description of the Prior Art", that electrical wires and cables commonly utilize conductors for transmission of signals (Page 1, lines 8-12). Specifically, with respect to claim 1, AOAPA discloses that tinsel conductors are a common replacement for conventional conductors because they lower skin effect and exhibit high frequency transmission (Page 3, lines 8-10), wherein the conductors of different cross sectional area are commonly utilized for conventional audio and video signal cables (Page 1, lines 8-12) and wherein the conductors may be made of silver copper alloy because such a conductor has a high material strength, is easy to process and the most practical for fabricating optimal conductance and rapid transmission, acoustic mellowness, transparency in audio and video cables (Page 2, lines 12-17), or made as tinsel conductors because tinsel conductors are a common replacement for conventional conductors because they lower skin effect and exhibit high frequency transmission (Page 3, lines 8-10), or made as enamel-covered wires because enamel wires are commonly utilized as replacements for conventional conductors because they exhibit high purity and conductivity, wherein the overall outer insulation diameter can be substantially reduced (Page 3, lines 3-7) or made of 100% fiber covered copper wire

Art Unit: 2831

because such wires are commonly utilized as replacement for conventional conductors because they reduce core outer diameter and thus the overall cable diameter, increase tensile strength, thereby prolonging service life (Pages 2-3, lines 18-20 & 1-2 respectively).

With respect to claim 1, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the conventional conductors of Eichmann to comprise the solid conductor being a plurality of insulated tinsel conductor, having different gauges, being two lengths of enamel covered wire or being two lengths of 100% fiber covered copper as taught by AOAPA because AOAPA teaches that such a configuration lowers skin effect and exhibits high frequency transmission (Page 3, lines 8-10), exhibits high purity and conductivity, wherein the overall outer insulation diameter can be substantially reduced (Page 3, lines 3-7) and increases tensile strength, thereby prolonging service life (Pages 2-3, lines 18-20 & 1-2 respectively).

With respect to claim 1, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the conventional conductors of Eichmann to comprise the solid conductor having different gauges as taught by AOAPA because AOAPA teaches that such a configuration is commonly utilized for conventional audio and video signal cables (Page 1, lines 8-12) and since such a modification would have involved a mere change in size of a component and a change of size is generally recognized as being within the ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

With respect to claim 1, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the conventional conductor of Eichmann to comprise the solid conductor to be silver copper alloy configuration as taught by AOAPA because AOAPA teaches that such a configuration conductors being made of silver copper alloy have a high material strength, are easy to process and the most practical for fabricating optimal conductance and rapid transmission, acoustic mellowness, transparency in audio and video cables (Page 2, lines 12-17) and since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

### ***Response to Arguments***

10. Applicant's arguments filed August 24, 2004 have been fully considered but they are not persuasive. Specifically, the applicant argues the following:

- A) The four paragraphs on Page 2, lines 12-13 of the subject Patent Application, as originally filed, are included to distinguish or differentiate the subject Patent Application system with the prior art and therefore the applicant did not intend to state that the prior art systems include silver-copper alloys, 100% fiber covered copper, enamel covered wire, tinsel.
- B) The combination of Eichmann and AOAPA doesn't teach or suggest the use of the these materials within an audio and video signal cable.



With respect to arguments A & B, the examiner respectfully traverses. Firstly, it has been held that the discussion of prior art in the Description of Prior Art section is an admission by the Applicant that such is Admitted Prior Art. Specifically, the MPEP states:

#### ADMISSIONS BY APPLICANT CONSTITUTE PRIOR ART

A statement by an applicant during prosecution identifying the work of another as "prior art" is an admission that that work is available as prior art against the claims, regardless of whether the admitted prior art would otherwise qualify as prior art under the statutory categories of 35 U.S.C. 102. *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed Cir. 2003). However, even if labeled as "prior art," the work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories. *Id.*; see also *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984) ("[W]here the inventor continues to improve upon his own work product, his foundational work product should not, without a statutory basis, be treated as prior art solely because he admits knowledge of his own work. It is common sense that an inventor, regardless of an admission, has knowledge of his own work."). Consequently, the examiner must determine whether the subject matter identified as "prior art" is applicant's own work, or the work of another. In the absence of another credible explanation, examiners should treat such subject matter as the work of another.

#### II. DISCUSSION OF PRIOR ART IN SPECIFICATION

Where the specification identifies work done by another as "prior art," the subject matter so identified is treated as admitted prior art. *In re Nomiya*, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA 1975) (holding applicant's labeling of two figures in the application drawings as "prior art" to be an admission that what was pictured was prior art relative to applicant's improvement).

In light of the above statement, it is respectfully submitted that the examiner's determination that the applicant is discussing prior art when referring to the paragraph four, because the applicant has not made any statements comparing the details of paragraph four to any previous known conductors. Specifically, the applicant discusses the silver-copper alloys, 100% fiber covered copper, enamel covered wire, and tinsel conductors as if they are known to provide certain stated characteristics. For instance, there are no statements such as "The applicant has found..." or "It has been found" but rather statements like "Silver copper alloys exhibit" and such. Therefore, given the above statements, the examiner respectfully submits, that the 35 USC 103(a) rejection is proper and just.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2831


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Communication***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Mayo III whose telephone number is (571)-272-1978. The examiner can normally be reached on M-F 8:30am-6:00 pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
William H. Mayo III  
Primary Examiner  
Art Unit 2831

WHM III

Application/Control Number: 10/725,551

Page 11

Art Unit: 2831

October 7, 2004